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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,766	01/02/2002	Jeffery Tabor	659/919	6310
7590	12/21/2004			
Robert N. Carpenter BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610			EXAMINER PURVIS, SUE A	
			ART UNIT 1734	PAPER NUMBER

DATE MAILED: 12/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/038,766

Applicant(s)

TABOR ET AL.

Examiner

Sue A. Purvis

Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,3,6-8 and 15-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2,3,6-8 and 17-20 is/are allowed.
- 6) ☒ Claim(s) 15,16 and 21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent; or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 15 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Kuntze et al. (US Patent No. 6,620,276 B1).

Kuntze discloses an apparatus for applying discrete parts onto a substrate web, the apparatus includes a transfer assembly (60) configured to rotate about an axis and which includes an outer surface configured to engage the discrete parts, and a web conveyor having an outer surface adapted to support and advance a substrate web, with the outer surface of the web conveyor including at least one recessed portion having a bottom surface capable of accommodating the discrete parts. (See Figures 2 & 4.)

Regarding claim 16, the web conveyor is spaced from the transfer assembly a distance less than the combined total thickness of the substrate web and the discrete part.

3. Claim 21 is rejected under 35 U.S.C. 102(b) as being anticipated by Blomqvist et al. (US Patent No. 3,847,710).

Blomqvist discloses an apparatus with a carrier body having a discrete part engaging outer surface, the outer surface including a generally convex surface and a generally convex recessed portion (3) spaced inwardly. The surface is adapted and configured to engage a discrete part having a thickness. The recessed portion having a bottom surface adapted and configured to engage the discrete part and further comprising at least one aperture (4) in the outer surface and extending through the carrier body for communication with a vacuum source. The carrier body is rotatable about an axis normal to the convex surface.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nomura et al. (US Patent No. 4,941,939) in view of Tomsovic, Jr. (US Patent No. 4,726,876) or Oshefsky et al. (US Patent No. 4,617,082).

Nomura discloses an apparatus for applying discrete parts onto a substrate web, the apparatus includes at least one transfer assembly configured (not detailed) which transfers the discrete parts to a web. Nomura also includes a web conveyor (1) having an outer surface adapted to support and advance a substrate web, with the outer surface of the web

Art Unit: 1734

conveyor including at least one recessed portion having a bottom surface capable of accommodating at least one portion of each of the discrete parts that is relatively thicker than other portions of each of the discrete parts. (Col. 4, lines 7-54.)

Nomura does not detail a transfer assembly configured to rotate about an axis. Nomura does suggest that particular types of this device are not critical so long as the device functions in the manner mentioned above in that it applies the substrate to the web.

A well known type of transfer member is a rotating one as seen in Tomsovic, Jr. or in Oshefsky.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a rotating transfer roll in the device of Nomura to place the discrete part on the web, because a rotating transfer roll is a well known method of transferring parts and Nomura suggests particular features of the device are not important, only that it transfers the substrate to the web.

Regarding claim 16, it is within the purview of the artisan to have the web conveyor spaced from the transfer assembly a distance less than the combined total thickness of the substrate web and the discrete part.

Response to Arguments

6. Applicant's arguments filed 07 December 2004 have been fully considered but they are not persuasive with respect to claim 21. Applicant argues that Blomqvist discloses that the carrier body is rotatable about an axis normal to the convex surface of the recessed portion. Rather, the carrier body of Blomqvist is rotated about an axis parallel to the convex surface (see Figure 1 of Blomqvist). Put another way, the rotation axis of Blomqvist is not normal, i.e. perpendicular, to any surface of the recessed portion. The examiner

Art Unit: 1734

disagrees because the edges of the recess surface are substantially normal to the axis of rotation as shown clearly in Figures 1 and 2.

Allowable Subject Matter

7. Claims 2, 3, 6-8, and 17-20 are allowed.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sue A. Purvis whose telephone number is (571) 272-1236. The examiner can normally be reached on Monday through Friday 9am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher A. Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sue A. Purvis
Primary Examiner
Art Unit 1734